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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/887,523	06/21/2001	Joel L. Passke	005127.00094	5745

22907 7590 12/13/2004

BANNER & WITCOFF  
1001 G STREET N W  
SUITE 1100  
WASHINGTON, DC 20001

EXAMINER

STASHICK, ANTHONY D

ART UNIT	PAPER NUMBER
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3728

27

DATE MAILED: 12/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/887,523

Applicant(s)

PASSKE ET AL.

Examiner

Anthony Stashick

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 9-13 and 16-53 is/are pending in the application.
- 4a) Of the above claim(s) 16-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ --Claim(s) 9-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on November 19, 2004 has been entered.

### ***Election/Restrictions***

2. Newly submitted claims 17-53 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the newly submitted claims place a pump in a specific location, between the bladder and the filter, whereas the original claims have the bladder and filter in communication with one another. Furthermore, the bladder in the newly submitted claims is not in communication with ambient air as previously claimed. Also, other claims add valves to the system that were not present in the earlier claimed invention.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 17-53 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Art Unit: 3728

*Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Colesnicenco Niculae 2,670,369 (Colesnicenco '369) in view of Opal Limited 1,074,193, Rogers 6,582,113 and Clark 6,044,577. Colesnicenco '369 discloses a sole structure; an air-filled bladder 6 in fluid communication with ambient air (through 1-3) and attached to the article of footwear (see Figure 6); a filter 1 in fluid communication with the bladder and ambient air (see Figures); the filter being structured to permit ambient air to enter the bladder; the filter being located in the upper. Colesnicenco '369 does not teach that the filter can restrict liquids and particulates from entering the bladder. Colesnicenco '369 does not teach that the filter can restrict liquids and particulates from entering the bladder, but specifies the use of felt or another filtering material for the filter (page 3, lines 20-22), the material makeup of the filter, a perforated layer located over the filter or the filter located in the sole of the shoe.

Rogers '113 teaches that filtering material can be made of expanded polytetrafluoroethylene (ePTFE) and that the ePTFE filter materials for air filtering were known in the art (col. 3, lines 63-64). The ePTFE is used in air breather filters for allowing air passage while preventing passage of contaminants such as particulate matter, water and/or oily materials (see col. 10, lines 29-35). Opal '193 teaches that ePTFE membranes were used in footwear for allowing air to flow while preventing or restricting liquids (see col. 3, lines 38-45). Rogers '113 further teaches that a laminated filter can be made of a material that is has hydrophobic and oleophobic properties due to the treatment of ePTFE, a

Art Unit: 3728

hydrophobic material (col. 2, line 8) with an oleophobic enhancement agent (col. 6, lines 30-33). Furthermore, Rogers '113 teaches that a scrim layer 224 (made of polypropylene as noted in col. 5, lines 51-54) can be layered with the ePTFE and perforated to allow air to flow through it but prevent large particulates and objects from contacting the filter. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to use a layered ePTFE membrane material as the filter material of Colesnicenco '369 to prevent or restrict contaminants from entering the compartment on the other side of the port in Colesnicenco '369.

Clark '577 teaches that the bladder and the filter can both be located within the sole unit (combination of sole, midsole, insole) to allow for ventilation of the shoe during the gait of the user. Therefore, it would have been obvious, in view of Clark '577, to place both the bladder and the filter in the sole of the shoe to allow for it to operate while the user walks.

### *Conclusion*

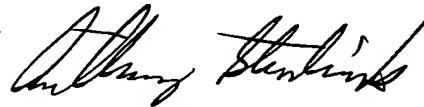
5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and are cited on form 892 enclosed herewith.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 703-308-3876. The examiner can normally be reached on Monday through Thursday from 6:30 am until 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3728

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anthony Stashick  
Primary Examiner  
Art Unit 3728

ADS